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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/475,703	12/30/1999	WOJCIECH K. SLUSAREK	78738EAR	6737

1333 7590 12/17/2002

PATENT LEGAL STAFF
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EXAMINER

CHEA, THORL

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 12/17/2002

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/475,703

Applicant(s)

SLUSAREK ET AL.

Examiner

Thorl Chea

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7-20 and 42-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-5,7-20 and 42-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 3-5, 7-20, 42-46 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification as originally filed fails to provide support for the language "in which ring the two carbon atoms to which T and R₁₂ are, respectively, attached are linked by a single bond" in claims 1, 11, 42 and 46. This language raises the issue of new matter.

The applicants argue that the claims are amended to more particularly and clearly define the invention such that, in the claimed invention, when structure R₁₂ and T combined to form a ring, the two carbon atoms to which T and R₁₂ are, respectively, attached remains linked by a single bond. This is consistent with the original disclosure in which all the compounds meet this limitation, which is necessary in order for the blocked compounds decompose by 1, 2 elimination mechanism to release photographically useful group on the thermal activation. In other words, the single bond between the two carbon atoms, shown in structure I between Link 2 and the X group, remain as shown in the structure I in the claims, i.e., the single bond does not change to aromatic bond as a result of any substitution or linking groups. This particular single

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bond is the key characteristic of the blocked compounds of the claimed invention and is important to unblocking mechanism and associated and consequent properties of the blocked compound of the present invention.

The argument is not persuasive. First, specification as originally filed fails to clearly differentiate between the ring forming by T and R12 which limits that the compound associated therewith is bound by a single bond when R12 and T(t) forms a ring.

Second, the specification fails to disclose whether the single bond which links the two carbons to which R12 and T(t) associated therewith does not change to an aromatic ring as the results of any substitution or the linking group or the single bond is not part of the ring such as aromatic ring. Third, the photographically useful group may be released the Link or Time group associated the compound, rather than the single bond linking T(t) and R12.

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification fails to provide support for the language "in which ring the two carbon atoms to which T and R₁₂ are, respectively, attached are linked by a single bond".

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3-5, 7-10, 11-12, 14-20, 42-46 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sato et al (Sato).

Sato discloses a heat developable photosensitive material containing a compound encompasses the scope of that of the present claimed invention. Note to the compound (Z) in column 2 and the exemplified compounds in columns 5-8 which contains an aromatic compound substituted with electron withdrawing group such as halogen group or CN group. The compound of the present claimed invention encompasses the scope of the compound of Sato when $T_{(1)}$ and R_{12} forms an aromatic groups. Therefore, the invention as claimed lacks novelty, and alternatively, it would have been obvious to the worker of ordinary skill in the art at the time the invention was made to from a developer within the scope taught by Sato with an expectation of achieving a material which has excellent preservability before use and provides color image having high image density and a low fog density.

Response to Arguments

7. Applicant's arguments filed September 24, 2002 have been fully considered but they are not persuasive since the single bond such as presented in the claims is still

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read on the single bond of the aromatic ring taught in Sato et al. The claims would be allowable if cancel the language such as "R12 can combine with T to form a ring" and newly amended language associated therewith.


Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (703)308-3498. The examiner can normally be reached on M-F (9:30 - 6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet C Baxter can be reached on (703)308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9301 for regular communications and (703)872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

tchea 
December 13, 2002


Thorl Chea
Primary Examiner
Art Unit 1752